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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

VO, HAI

ART UNIT	PAPER NUMBER
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1771

DATE MAILED: 09/19/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/904,375

Applicant(s)

BUGNET ET AL.

Examiner

Hai Vo

Art Unit

1771

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 14-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 14-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

***Sp cification***

1. The abstract of the disclosure is objected to because line 7, the word "foam" is misspelled and should be changed to --form--, line 8, the phrase "polymerizing oxidation-doping" needs to be changed to --polymerizing by oxidation-doping--. The Correction is required. See MPEP § 608.01(b).

The specification is objected to because of the following informalities:

Page 1, line 2, the status of Patent Application Ser. No. 08/691,241 needs to be updated.

Page 3, line 22; page 6, line 25, the word "pyrolysis" is misspelled.

Page 12, line 24, the word "know" needs to be changed to --known--.

Page 12, line 26, the word "pyrolle" is misspelled. Appropriate correction is required.

The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant in the next response is required to review his specification in order to identify other errors, if any and correct them.

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 14-32 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 14:

line 3, the limitation "developed surface" lacks antecedent basis.

line 5, the phrase "pre-metallization" needs to be changed to -- pre-metallizing --and it is unclear whether the porous material is pre-metallized with a conductive polymer or the metal is pre-metallized with a conductive polymer.

line 7, the phrase "a base structure" is vague and indefinite. Does Applicant mean a base structure is a structure of a porous material or a structure of other material?

In claim 18, line 2, polypyrrole is a polymer and cannot be a selected monomer.

In claim 22, lines 1 and 2, the term "electroplating" is confusing. Does Applicant mean that the electroplating in line 2 is of the same step of electroplating recited in claim 14 or a separate electroplating step in addition to the electroplating step recited in claim 14?

In claim 25, line 4, the phrase "superposition of at least two of said metals" is vague and indefinite because the selected metal can not be superposition of at least two of said metals.

In claims 27 and 28, line 2, the phrase "polymerization of oxidization-doping" is vague and indefinite because how can oxidization-doping be polymerized? Does Applicant mean polymerization by oxidization-doping of the monomer?

In claims 29 and 30, line 2, the phrase "oxidizing pre-treatment" lacks antecedent basis.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 14-32 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over WO94/25967. US 5,683,744 to Jolly et al is an equivalent form of WO94/25967 and will be relied on as the English translation of WO94/25967. The examiner interprets that any article produced by the process as set forth in claim 14 would have a layer construction as follows: a metal layer/a layer of conductive polymer/a porous substrate. Jolly discloses an article comprising a porous polyester fabric being covered with a uniform polypyrrole coating (example 1). Jolly also discloses copper or nickel can be electrochemically deposited on the conductive textile (column 9, lines 5-8). With regard to claims 14-16, 19-24, and 26-31, It is the examiner's position that the article of Jolly is identical to or only slightly different than the claimed article prepared by the method of the claim, because both articles are made of the same materials, having structural similarity (a metal layer/a layer of conductive polymer/a porous substrate). Even though product-by-process claims are limited by and defined by the process, **determination of patentability is based on the product itself.** The patentability of

a product does **not** depend on its method of production. If the product in the product-by-process claim is the same as or an obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 227 USPQ 964, 966 (Fed. Cir. 1985). The burden has been shifted to the applicant to show unobvious differences between the claimed product and the prior art product. *In re Marosi*, 218 USPQ 289,291 (Fed. Cir. 1983). The Jolly reference either anticipated or strongly suggested the claimed subject matter. It is noted that if the applicant intends to rely on Examples in the specification or in a submitted Declaration to show non-obviousness, the applicant should clearly state how the Examples of the present invention are commensurate in scope with the claims and how the Comparative Examples are commensurate in scope with Jolly.

7. Claims 14-32 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over JP 06248491 or DE 4023619. JP'491 discloses an article comprising a porous polyurethane foam being covered with a uniform polypyrrole coating and a nickel layer being deposited on the conductive polypyrrole coating (abstract). DE'619 discloses an article comprising a porous needle felt being covered with a conductive polypyrrole coating and a metal layer being deposited on the conductive polypyrrole coating (abstract). With regard to claims 14-16, 19-24, and 26-31, It is the examiner's position that the article of JP'491 or DE'619 is identical to or only slightly different than the claimed article prepared by the method of the claim, because both articles are made of the same materials, having structural similarity (a metal layer/a layer of conductive polymer/a

porous substrate). Even though product-by-process claims are limited by and defined by the process, **determination of patentability is based on the product itself**. The patentability of a product does **not** depend on its method of production. If the product in the product-by-process claim is the same as or an obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 227 USPQ 964, 966 (Fed. Cir. 1985). The burden has been shifted to the applicant to show unobvious differences between the claimed product and the prior art product. *In re Marosi*, 218 USPQ 289,291 (Fed. Cir. 1983). The JP'491 or DE'619 reference either anticipated or strongly suggested the claimed subject matter. It is noted that if the applicant intends to rely on Examples in the specification or in a submitted Declaration to show non-obviousness, the applicant should clearly state how the Examples of the present invention are commensurate in scope with the claims and how the Comparative Examples are commensurate in scope with JP'491 or DE'619.

### **Conclusion**

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hai Vo whose telephone number is (703) 605-4426. The examiner can normally be reached on Monday to Friday, 8:30 to 5:00 (EAST). If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on (703) 308-2414. The fax phone numbers for the organization where this application or proceeding is assigned are

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(703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

HV  
September 12, 2002



TERREL MORRIS  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1700